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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,901	03/09/2004	Joetta Renee Palmer	0102417-0521925	1630
26874 7590 07/28/2008 FROST BROWN TODD, LLC 2200 PNC CENTER 201 E. FIFTH STREET CINCINNATI, OH 45202				
EXAMINER NGUYEN, TUAN VAN				
ART UNIT		PAPER NUMBER		
3731				
NOTIFICATION DATE		DELIVERY MODE		
07/28/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@fbtlaw.com

Office Action Summary

Application No.

10/796,901

Applicant(s)

PALMER ET AL.

Examiner

TUAN V. NGUYEN

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group II of claims 43-70, drawn to method for separating tissue in the reply filed on April 16, 2008 is acknowledged. Claims 27-42 and 71-79 have been Election was made **without** traverse in the reply filed on April 16, 2008.

Specification

2. The disclosure is objected to because of the following informalities:
 - (i) page 3, lines 22-23 include the phrase "dissector 10 includes and elongate shaft," where "and" should be replaced with "an."
 - (ii) page 5, lines 6-7 include the phrase "in such situations, the locating the distal," which should be replaced with "in such situations, locating the."
 - (iii) page 5, line 33 contains the phrase "aligned with" repeated in the same sentence.
 - (iv) page 6, line 18 includes the phrase "that the after the surgeon," which should be replaced with "that after the surgeon."
 - (v) page 6, line 24 includes the phrase "the geometry of present example," where "the" is missing.Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 43, 44, 47-51, 53, 54, 55, 56, and 59-68 are rejected under 35 U.S.C. 102(b) as being anticipated by Boyd et al. (Pub No. US 2002/0087183).**
5. Boyd discloses (Figs. 22-51) a method for separating a tissue at a selected site comprising: positioning a dissection surface of a dissector 140 near to selected tissue, the dissector including an elongated shaft 141 with a dissecting surface at a distal end 144; advancing the dissecting surface through the selected tissue to create a desired dissection path while monitoring the position indicator through the tissue; and simultaneously articulating the dissecting surface relative to the shaft (paragraphs [0091]-[0098]).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
8. **Claims 45-47, 57, 58, and 69-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyd et al. as applied to claims 43, 55 and 67 above and further in view of Wagner (US 2004/02/04734 A1).**
9. Boyd discloses the invention substantially as claimed except for the dissector includes a port for fluid dissection and a working lumen. However, Wagner discloses a surgical dissection tool should includes a working lumen and a port for fluid dissection for the purpose of delivering the pharmacological agent, for example, saline solution, phosphated buffer solution, an analgesic, an antibiotic, a hemostatic agent, an anti-inflammatory, or other useful drug or fluid, thereby, improving wound healing (paragraph [0040]).
10. **Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boyd et al. and Wagner as applied to claim 43 above and further in view of Chin (Pub No. US 2004/0102804 A1).**
11. Boyd as modified by Wagner discloses a method of separating tissue at a selected site substantially as claimed except for the steps are part of a procedure for treating atrial fibrillation. However, Chin discloses using a dissector for performing

steps of treating atrial fibrillation is old and well known in the art (paragraph [0253]), therefore, it would have been obvious to one of ordinary skill in the art to further utilize the device and method of Boyd as modified by Wagner in the field of treating atrial fibrillation.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan V. Nguyen whose telephone number is 571-272-5962. The examiner can normally be reached on M-F: 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/T. V. N./

Examiner, Art Unit 3731

Art Unit: 3731

/Todd E Manahan/

Supervisory Patent Examiner, Art Unit 3731